REMARKS

Applicants submit these remarks in response to the Office Action dated June 15, 2005. No fee is believed to be due in connection with this submission. In the event that any fees are determined to be due in connection with the filing of this response please charge necessary fees to Deposit Account No. 23-2415 referencing Docket No. 30923-715.201.

Applicants note with appreciation the withdrawal of the rejection under 35 U.S.C. § 101. For at least the reasons set forth below, Applicants respectfully submit that the rejection under 35 U.S.C. § 102(e) based on Cramer *et al.* should also be withdrawn. Accordingly, it is believed that the application is in condition for allowance, and such favorable action is respectfully requested.

The Claims Define Novel Subject Matter

The Examiner has maintained the rejection of Claims 1, 2, 7, 8, 10-26, 31, 32, and 34-48 under 35 U.S.C. § 102(e)(2) as allegedly being anticipated by Cramer *et al.* (U.S. Patent No. 6,240,374). For the reasons set forth below, Applicants respectfully traverse the rejection.

As noted by the Federal Circuit, anticipation under 35 U.S.C. § 102 occurs only "when the same device or method, having all of the elements contained in the claim limitations, is described in a single prior art reference." *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367 (Fed. Cir. 2002). "A single prior art reference anticipates a patent claim if it expressly or inherently describes each and every limitation set forth in the patent claim." *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292 (Fed. Cir. 2002). Moreover, the "single reference must describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art." *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116 (Fed. Cir. 2002).

The present Office Action essentially reiterates the reasoning set forth in the prior Office Action. It is respectfully submitted that the sections relied upon in the Office Action (and Cramer *et al.* in its entirety) fail to disclose each element of the claimed invention.

As set forth in Claim 1, the subject invention is directed to a computer implemented method of analyzing a non-enumerated virtual library. The method includes the following steps:

(a) randomly selecting a set of N reagent combinations from the non-enumerated virtual library, wherein said selected N reagent combinations represent a set of N compounds;

(b) enumerating said set of N compounds;

(c) selecting M compounds from said set of N enumerated compounds wherein the selection of M compounds from said set of N enumerated compounds is based on at least one fitness function;

(d) deconvoluting said M compounds into their associated building blocks;

(e) generating said focused library of at least one compound based on said building blocks; and

(f) enumerating at least one compound in said focused library of at least one compound;

(g) selecting at least one K compound; and

(h) synthesizing said at least one K compound.

Cramer *et al.* does not disclose each feature of Claim 1. For example, Cramer *et al.* does not disclose steps "(d) deconvoluting said M compounds into their associated building blocks" and "(e) generating said focused library of at least one compound based on said building blocks."

The Office Action on page 3 states the following: "[t]he structural core, and other structural building blocks are then defined as the core, fpcard, and fp in column 65, line 59, through column 66, line 65, as also required in instant claim 1, part (d), regarding deconvoluting the selected M compounds into separate files."

Apparently, the Office Action is alleging that column 65, line 59, through column 66, line 65 of Cramer *et al.* discloses steps (d) and (e) as recited in present Claim 1. Applicants respectfully, but strenuously disagree. It is respectfully submitted that neither the section of Cramer *et al.*, relied upon in the Office Action, nor any other section of Cramer *et al.* discloses "deconvoluting said M compounds into their associated building blocks" and generating a smaller focused library based on the building blocks as recited in the present claims and further defined in the specification.

The present specification discloses on page 19, lines 12-19:

> "[o]nce M compounds are selected, based on the fitness function, from the first set of enumerated compounds, these M compounds are deconvoluted into their building blocks **(i.e. reagents)**, in step 110.
>
> In step 112, the building blocks resulting from step 110 are combined into lists of "preferred" reagents and are used to produce a smaller "focused" library. This focused library can be thought of a sub-matrix of the larger matrix that represents the entire original virtual combinatorial library."

Neither the section relied upon in the Office Action, nor any other section of Cramer *et al.* discloses the step of ((e)) generating smaller focused library of at least one compound based on building blocks selected as preferred reagents (in prior step (d)).

Steps (e) and (d) are recited in all the independent claims now pending in the application. The Cramer *et al.* reference fails to disclose steps (e) and (d) recited in the present independent claims and therefore cannot properly anticipate those claims. Moreover, as none of the independent claims are anticipated by the Cramer *et al.* reference, none of the dependent claims can be anticipated. Accordingly, the rejection under 35 U.S.C. § 102(e)(2) should be withdrawn.

CONCLUSION

Applicants believe that for the reasons set forth above, claims 1, 2, 7, 8, 10-26, 31, 32 and 34-48 are allowable. Prompt and favorable action is therefore respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (858) 350-2337.

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

Dated: September 15, 2005

Samir Elamrani, Agent for Applicant
Registration No. 43,601